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09/802,978	03/12/2001	Hyo Sik Jeon	K-264	6940

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EXAMINER

JACKSON, BLANE J

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,978

Applicant(s)

JEON ET AL.

Examiner

Blane J Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

RESPONSE TO AMENDMENT

Response to Arguments

1. Applicant's arguments filed 11/14/-3 have been fully considered but they are not persuasive. Lim, U.S. Patent 6,349,224, figures 4-6, not the prior art of figure 1, teaches the same basic system as does the instant invention: a method of digital data transmission between mobile telephones without the use of an Interworking Unit (IWU) as disclosed in the respective Specifications and indirectly addressed in the respective claims. Since Lim and the instant application share the same assignee and for the reasons discussed in this Office Action, a double patenting rejection follows and subsequent rejection of the amended and new claims. Consequently, this is a non-final rejection.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-20 are rejected under the judicially created doctrine of double patenting over claims 1-26 of U. S. Patent No. 6,349,224 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: The patent of Lim and the instant application are concerned with a method for data communication between two wireless radiotelephones where the system does not employ an Interworking Unit (IWU) clearly discussed in the Specification and reflected in the claims of the Lim patent and instant application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Lim (U.S. Patent 6,349,224).

As to claim 1, Lim teaches a method for making a data service in a communication system including:

Defining a particular service option on data service between a first mobile station and a second mobile station within the same network (figures 5 and 6, column 3, lines 1-12)

Setting up a data traffic path between a base station controller, the first mobile station and the MSC when the first mobile station requests the data service according the particular service option (column 4, lines 20-49),

Checking the second mobile station making a response through the MSC according to the particular service option (column 4, lines 49-66),

Setting up the data traffic path between the first mobile station and the second mobile station by using the MSC and the base station controller when the second mobile station makes the response according to the particular service option (column 4, line 66 to column 5, line 8, and,

Carrying out data service between the first mobile station and the second mobile station through the data traffic path wherein the data traffic path travels *through* the MSC only once and the MSC services both the first mobile station and the second

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mobile station (figures 5 and 6 show the protocol where the data traffic path travels *through* the MSC only once with one MSC controlling base stations BS-0 (originating) and BS-T (terminating), column 4, line 20 to column 5, line 42 – Note: reference, under heading of figure 4 teaches the architecture of figures 5 and 6 – one MSC, two BSC's).

As to claim 2, Lim teaches the MSC sets up the data traffic path between the first and second mobile station in interlock with a BSP, a CCP and a SBP in the base station controller (figures 5 and 6). It would be inherent for the system of LIM to functionally include at least one base station controller within the network with processors to direct the base stations under supervision of the MSC.

As to claims 3 and 4, Lim teaches a method for making a data service in a communication system including:

Defining a particular service option on mutual data service between a first mobile station and a second mobile station within the same network,

When the first mobile station requests a call for the data service, the MSC checking the call being requested according to the particular service option (column 4, lines 30-49),

When the call is requested according to the particular service option, setting up a RLP between the first mobile station, and origination side base station and the MSC through a voice channel element (VCE) in a base station controller (column 4, lines 52-55),

Requesting a paging for the data service from the MSC to the second mobile station that is a destination side (column 4, lines 49–52),

When the second mobile station makes a response to the paging according to the particular service option, setting up a RLP between the second mobile station, the destination side base station and the base station controller through the VCE (column 4, line 66 to column 5, line 4),

Setting up a data traffic path between the first mobile station and the second mobile station by means of the MSC (column 5, lines 4-8), and,

Carrying out the data service between the first mobile station and the second mobile station through the data traffic path wherein the data traffic path travels through the MSC only once and the MSC services both the first mobile station and the second mobile station (figures 5 and 6, column 5, lines 9-14).

As to claim 5, Lim teaches wherein a Point to Point Protocol (PPP) is set up between the origination side first mobile station and the destination side second mobile station (column 5, lines 4-8).

As to claims 6 and 8, Lim teaches an origination and terminating mobile station within the same wireless network in communication with a particular data service option (column 4, lines 30-35). Lim teaches the originating side base station (and inherent base station controller) sets up a RLP with the request for the particular data service option and the originating mobile station actuates a Point to Point protocol (PPP). Lim

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teaches that once the terminating mobile gives a response, a RLP is opened between the terminating side base station and the terminating mobile data terminal. Lim further teaches the MSC completes the set up of a data traffic path for data transmission between the originating and terminating mobile stations through the origination and terminating side base stations (column 4, line 66 to column 5, line 6).

As to claim 7, Lim teaches a PPP is set up between the origination mobile station and the destination mobile station by means of the MSC (column 5, lines 4-8).

As to claim 9, Lim teaches a wireless network where the functions of the base station controller are required but is not clear as to how or where the base station controller functions are located. However, it is well known in the art to provide the functionality of the base station within an MSC, within a base station or to distribute the base station controller function in separate regions depending on the size of the network.

As to claim 10, Lim teaches a data terminal with an asynchronous or FAX type application connected to the mobile terminal through a standard interface such as RS-232 (figure 4, column 4, lines 20-33).

6. Claims 11-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Preston et al. (U.S. Patent 6,681,121).

As to claims 11 and 16, Preston teaches a mobile switching center wherein:

If the mobile switching center is configured to service a first mobile unit over a first communication path and,

If the mobile switching center is configured to service a second mobile unit over a second communication path,

Then the mobile switching center is configured to connect the first communication path and the second communication path at the mobile switching center (figure 1 represents a usual cellular telecommunications switching system CTSS (38) with wireless connection to the cell phone (14) and landline connections or equivalent to the PSTN (42), Internet (46) and a server/ ISB modem (40), (28), column 2, lines 54 to 67).

As to claims 12, 13, 17 and 18, Preston teaches voice/ digital data transmission between mobile telephones, mobile to PSTN, mobile to Internet etc. where the infrastructure would include any usual configuration of mobile switching centers to switch the call between the design number of base station controllers and base stations depending on the location of the calling and called party (figure 1, column 2, lines 63 to column 63, line 5).

As to claims 14, 15, 19 and 20, Preston discloses a method for transmission of voice and digital data concurrent over a digital voice channel between mobile stations (figures 2, 3 and 9, column 3, line 41 to column 4, line 27 and to disclose the digital data is processed at the radiotelephones without additional equipment at the MSC, column 6,

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line 56 to column 7, line 15, also, note the data output port of figure 9 to the data external device or phone screen display, separate from the usual audio speaker and receiver (17)).

Conclusion

7. The additional prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bonnard et al. (U.S. Patent 6,633,840) discloses and method for transmitting data on a speech channel. Joong (U.S. Patent 6,549,776) discloses a method for transmitting a data packet from a server to a wireless client with direct digital calls using a Interworking Function/ Direct Access Unit (IWF/DAU) at the MSC.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blane J Jackson whose telephone number is (703) 305-5291. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (703) 305-4385. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 812-9314 for regular communications and (703) 812-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377).

BJJ

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